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PAUL W. MARTIN NCR CORPORATION, LAW DEPT. 1700 S. PATTERSON BLVD. DAYTON, OH 45479-0001			ART UNIT 3622	PAPER NUMBER

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09832767

Filing Date: 11 April 2001

Appellant(s): McGregor et al.

James D. Wood, Esq., For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 August 2006 appealing from the Office action mailed 20 March 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Park, US 20010025254A1, 27 September 2001

Microsoft Press Computer Dictionary, 3rd ed. (Redmond WA: Microsoft Press, 1997).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the non-final rejection mailed on 20 March 2006.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 14 December 2005 have been fully considered but they are moot in view of the following new basis of rejection.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of 35 U.S.C. 102 which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14, 15, 17-19, 21, 22, 24, 25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Park (US 20010025254A1).
5. Park teaches (independent claim 14, 18 and 21, and dependent claims 17, 22 and 27) a method for advertising/generating revenue by sending email messages appended with advertising, comprising the steps of (para. [0022]): transmitting an email message (Fig. 5) addressed to at least one email recipient from a first client computer through at least one computer network (*Internet 20*, para. [0041]); appending an *electronic stamp* advertisement retrieval software means to the email message, wherein the *electronic*

stamp/ad retrieval software means comprises information about at least one of a plurality of ads retrievably stored in a database (*electronic stamp server 12*, para. [0041]); transmitting the email message to a second client computer (para [0046], *step S14*); and displaying the email message at the second client computer (*a corresponding receiver*, para. [0047]), wherein when the email message is first displayed on the *corresponding receiver*/second client computer the *electronic stamp 52/ad* retrieval software means is operable at the *corresponding receiver*/second client computer to retrieve at least one of the ads retrievably stored the *electronic stamp server 12* database (para. [0056]-[0059]).

6. Park does not explicitly teach an (email) host server. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the reference does teach a conventional email system (i.e., using the common *POP3* email protocol, para. [0045] and Microsoft Press Computer Dictionary, and using *Outlook Express from Microsoft Corporation*, para. [0046]). Such an email system necessarily operates with an email server.
7. Park also teaches (claims 18 and 27) accounting for a contribution (*amount to be paid*, para. 0061]) and (claims 17 and 21) accounting for advertising revenue (para. [0060]).
8. Park also teaches: targeted advertising based on user profile information (claims 15, 19, 24 and 25, para. [0043]).
9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park (US 20010025254A1). Park does not teach a third computer. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to store ads in a specialized ad server, which reads on a third computer.

(10) Response to Argument

Argument for claims 14, 15, 17-19, 21, 22, 24, 25 and 27 as being anticipated by Park

Claim 14

Appellant argues (p. 14) that the examiner has misconstrued the claim. In fact, appellant does not understand the rejection, and has presumed that it is wrong. The pertinent part of the rejection is as follows.

“appending an *electronic stamp* advertisement retrieval software means to the email message, wherein the *electronic stamp*/ad retrieval software means comprises information about at least one of a plurality of ads retrievably stored in a database (*electronic stamp server 12*, para. [0041]);” (Para. 5 of the rejection mailed on 20 March 2006 and reproduced above.)

The *electronic stamp* taught by the reference reads on the claimed “advertisement retrieval software means” because it contains a hyperlink:

“[0043] The electronic stamp 52 appended to the electronic mail contains a stamp image 54, identification information 56 and a link to be connected to the electronic stamp providing system 10.” (Park, para. [0043], emphasis added.)

The application does not contain a special “clear definition” (MPEP § 2111.01) for the terms “software” or “software means”. Hence, the examiner is obligated to give these claim terms their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). It is widely accepted in the art that “software” is an executable computer instruction. (“Instructions that make hardware work”, Appendix p. A1 from the Microsoft Press Computer Dictionary, 3rd ed.) Those skilled in the art would interpret “software means” to have the same meaning as “software”. A hyperlink is executable (“The user activates the link”, Appendix p. A2 from the Microsoft Press Computer Dictionary, 3rd ed.) Hence, the *electronic stamp* is “software means” that meets the limitations of the claim.

Claim 21, 22 and 24

For independent claim 21, appellant repeats the argument used for claim 14 (pp. 12-13). Here the *electronic stamp* taught by the reference reads on the claimed appended “sub-message”. Said *electronic stamp*/sub-message is “associated with an advertisement”:

“The electronic stamp server 12 provides an electronic stamp program 32 and various and customized online advertisements using the electronic stamp.” (Park, para. [0041], emphasis added.)

Claims 22 and 24 depend on claim 21. Appellant gives no new arguments for their patentability.

Claims 15 and 25

These two claims are similar and respectively depend on independent claims 14 and 21 discussed above. Appellant gives the following argument at the bottom of p. 13:

“Claim 15 thus recites that the advertisement retrieval software is selected by the system based upon profile information of the sender of the e-mail.” (Emphasis added.)

That is not what is claimed. It is claimed that the advertisement, not the ad retrieval software, is selected by the system based upon profile information of the user, not the sender, of the e-mail.

Appellant argues (middle of p. 14) that “the stamp of Park is a generic stamp”, i.e., that it is not used to target ads. That is incorrect. Para. [0043] of Park contains in part:

“In the identification information 56 contained in the electronic stamp 52, there are, for example, an ID (identification) field of a user, an electronic mail ID field of the user, ...”

It is this user information that is used to target the ad.

Appellant also argues (middle of p. 14), “the advertisement is not appended to the e-mail”. First, it is claimed that the advertisement retrieval software means, not the ad itself, is appended to the e-mail. Second, it has been shown above for parent claim 21 that the reference does teach appending an *electronic stamp* advertisement retrieval software means to the email message.

Appellant argues (p. 15, 2nd and 3rd lines from the bottom), “... Park does not disclose appending advertisement retrieval software based upon sender information.” Of course not, because there is no such limitation in the claims. The claims are limited to user information. There is no limitation to “sender” information.

Appellant argues (center of p. 16) that claim 25 is similar to claim 15 and therefore patentable for the same reasons. It has been shown that claim 15 is not patentable, so neither is claim 25.

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Claim 17

Appellant argues (p. 18, top), "In contrast, claim 17 recites that the return message which initiates an accounting is sent 'when the e-mail message is displayed.'"

That is not correct. The correct limitation of claim 17 is

"accounting for advertising revenue and advertising expense in response to the receipt of the return communication by the host server." (Emphasis added.)

The accounting is done "in response to the receipt of the return communication by the host server". That is taught at para. [0060] of Park.

Claims 18 and 27, and claim 19

Appellant repeats previous arguments.

Argument for claim 23 as being unpatentable over Park

Appellant does not introduce new arguments.

(11) Related Proceeding(s) Appendix

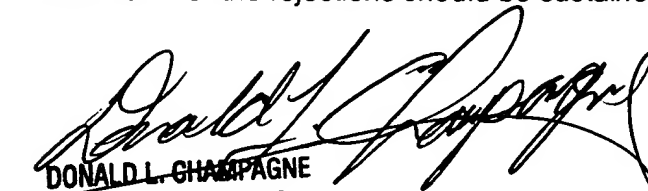
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Donald L. Champagne
Primary Examiner
Art Unit 3622



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Conferees:

Jeffrey D. Carlson



Eric W. Stamber



8 November 2006

ber, which identifies the service. For example, port 80 on an Internet node indicates a Web server. *See also* port number. **2.** The receptacle part of a connector, which receives a plug. *See also* female connector.

soc. newsgroups \sōsh`dot nōōz`grōōps\ *n.* Usenet newsgroups that are part of the soc. hierarchy and have the prefix soc. These newsgroups are devoted to discussions of current events and social issues. Soc. newsgroups are one of the seven original Usenet newsgroup hierarchies. The other six are comp., misc., news., rec., sci., and talk. *See also* newsgroup, traditional newsgroup hierarchy, Usenet.

soft \soft\ *adj.* **1.** In computing, temporary or changeable. For example, a soft error is a problem from which the system can recover, and a soft patch is a temporary program fix that holds only while the program is running. *Compare* hard (definition 1). **2.** In electronics, characterized by magnetic materials that do not retain their magnetism when a magnetic field is removed. *Compare* hard (definition 2).

soft boot \soft`bōōt\ *n.* *See* warm boot.

soft copy \soft`kop`ē\ *n.* The temporary images presented on a computer display screen. *Compare* hard copy.

soft error \soft`âr`er\ *n.* An error from which a program or operating system is able to recover. *Compare* hard error.

soft font \soft font\ *n.* *See* downloadable font.

soft hyphen \soft`hī`fən\ *n.* *See* hyphen.

soft link \soft`lēnk\ *n.* *See* symbolic link.

softmodem \soft`mō`dām\ *n.* *See* software-based modem.

soft patch \soft pach\ *n.* A fix or modification performed only while the code being patched is loaded into memory, so that the executable or object file is not modified in any way. *See also* patch¹.

soft return \soft`rə`turn\ *n.* A line break inserted in a document by a word processor when the next word in the current line of text would cause the line to overflow into the margin—a movable line break. *See also* wordwrap. *Compare* hard return.

soft-sectored disk \soft`sek`tərd disk\ *n.* A disk, especially a floppy disk, whose sectors have been marked with recorded data marks rather than

punched holes. *See also* index hole. *Compare* hard-sectored disk.

software \soft`wâr\ *n.* Computer programs; instructions that make hardware work. Two main types of software are system software (operating systems), which controls the workings of the computer, and applications, such as word processing programs, spreadsheets, and databases, which perform the tasks for which people use computers. Two additional categories, which are neither system nor application software but contain elements of both, are network software, which enables groups of computers to communicate, and language software, which provides programmers with the tools they need to write programs. In addition to these task-based categories, several types of software are described based on their method of distribution. These include packaged software (canned programs), sold primarily through retail outlets; freeware and public domain software, which are distributed free of charge; shareware, which is also distributed free of charge, although users are requested to pay a small registration fee for continued use of the program; and vaporware, software that is announced by a company or individuals but either never makes it to market or is very late. *See also* application, canned software, freeware, network software, operating system, shareware, system software, vaporware. *Compare* firmware, hardware, liveware.

software-based modem \soft`wâr-bāsd mō`dām\ *n.* A modem that uses a general-purpose, reprogrammable digital signal processor chip and RAM-based program memory rather than a dedicated chip with the modem functions burned into the silicon. A software-based modem can be reconfigured to update and change the modem's features and functions.

software-dependent \soft`wâr-də`pen`dant\ *adj.* Of, pertaining to, or being a computer or device that is tied to a particular program or set of programs developed for it.

software engineering \soft`wâr en`jə`nēr`ēng\ *n.* The design and development of software. *See also* programming.

software handshake \soft`wâr hand`shāk\ *n.* A handshake that consists of signals transmitted over the same wires used to transfer the data, as in

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hyperlink

hyperlink \hī'pər-lēnk\ *n.* A connection between an element in a hypertext document, such as a word, phrase, symbol, or image, and a different element in the document, another hypertext document, a file, or a script. The user activates the link by clicking on the linked element, which is usually underlined or in a color different from the rest of the document to indicate that the element is linked. Hyperlinks are indicated in a hypertext document through tags in markup languages such as SGML and HTML. These tags are generally not visible to the user. Also called hot link, hypertext link. See also anchor (definition 2), HTML, hypermedia, hypertext, URL.

hypermedia \hī'pər-mē'dē-ə\ *n.* The integration of any combination of text, graphics, sound, and video into a primarily associative system of information storage and retrieval in which users jump from subject to related subject in searching for information. Hypermedia attempts to offer a working and learning environment that parallels human thinking—that is, one in which the user can make associations between topics, rather than move sequentially from one to the next, as in an alphabetic list. For example, a hypermedia presentation on navigation might include links to astronomy, bird migration, geography, satellites, and radar. If the information is primarily in text form, it is regarded as hypertext; if video, music, animation, or other elements are included, the information is regarded as hypermedia. See also hypertext.

hyperspace \hī'pər-spās\ *n.* The set of all documents that can be accessed by following hyperlinks in the World Wide Web. Compare cyberspace (definition 2), Gopherspace.

HyperTalk \hī'pər-tāk\ *n.* The programming language used to manipulate HyperCard stacks. See also HyperCard.

hypertext \hī'pər-tekst\ *n.* Text linked together in a complex, nonsequential web of associations in which the user can browse through related topics. For example, in an article with the word *iron*, traveling among the links to *iron* might lead the user to the periodic table of the elements or a map of the migration of metallurgy in Iron Age Europe. The term *hypertext* was coined in 1965 to describe documents presented by a computer that

hysteresis

express the nonlinear structure of ideas as opposed to the linear format of books, film, and speech. The term *hypermedia*, more recently introduced, is nearly synonymous but emphasizes the nontextual element, such as animation, recorded sound, and video. See also HyperCard, hypermedia.

hypertext link \hī'pər-tekst lēnk\ *n.* See hyperlink.

Hypertext Markup Language \hī'pər-tekst mār'k'up lang'wəj\ *n.* See HTML.

Hypertext Transfer Protocol \hī'pər-tekst trans'fər prō'tə-kol\ *n.* See HTTP.

Hypertext Transfer Protocol Daemon \hī'pər-tekst trans'fər prō'tə-kol dē'mən\ *n.* See HTTPd.

Hypertext Transfer Protocol Next Generation \hī'pər-tekst trans'fər prō'tə-kol nekst' jen-ər-ə'shən\ *n.* See HTTP-NG.

HyperWave \hī'pər-wāv\ *n.* A World Wide Web server that specializes in database manipulation and multimedia.

hyphen \hī'fən\ *n.* A punctuation mark (-) used to break a word between syllables at the end of a line or to separate the parts of a compound word. Word processing programs with sophisticated hyphenation capabilities recognize three types of hyphens: normal, optional, and nonbreaking. Normal hyphens, also called *required* or *hard hyphens*, are part of a word's spelling and are always visible, as in *long-term*. Optional hyphens, also called *discretionary* or *soft hyphens*, appear only when a word is broken between syllables at the end of a line; they are usually supplied by the word processing program itself. Nonbreaking hyphens are always visible, like normal hyphens, but they do not allow a line break. See also hyphenation program.

hyphenation program \hī-fə-nā'shən prō'gram\ *n.* A program (often included as part of a word processing application) that introduces optional hyphens at line breaks. A good hyphenation program will avoid ending more than three lines in a row with hyphens and will prompt the user for confirmation or tag ambiguous breaks, as in the word *desert* (did the army de-sert in the des-ert?). See also hyphen.

hysteresis \hī'stər-ē'sis\ *n.* The tendency of a system, a device, or a circuit to behave differently